

**REMARKS**

Applicants concurrently file herewith a Petition for Extension of Time, and a corresponding extension of time fee, for a one-month extension of time.

Claims 1, 3-16 and 18 are all the claims presently pending in the application. Claims 1, 3, 5-7, 11, 12, 15, 16 and 18 have been amended to more particularly define the invention. Claims 2, 17 and 18 have been canceled without prejudice or disclaimer.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner which would require further search and/or consideration. That is, the subject matter of claims 2 and 17 have merely been incorporated into the independent claims.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-15, 18, and 19 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite and under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1, 2, 5, 6, 8, 9, and 11-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Onuma, et al. (U.S. Patent No. 5,605,778) (hereinafter “Onuma”), as evidenced by Shaffert (“Electrophotography”, John Wiley & Sons, New York, 1975, page 604) (hereinafter “Schaffert”). Claims 4 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Onuma. Claims 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Onuma. Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Onuma. Claims 1, 6, and 11-14 stand rejected under 35 U.S.C. §102(e) as being anticipated by Bartel, et al. (U.S. Patent No. 6,808,851) (hereinafter “Bartel”), as evidenced by Fields, et al. (U.S. Publication No. 2003/0049552 A1) (hereinafter “Fields”) and Sacripante, et al. (U.S. Patent No. 6,849,371) (hereinafter “Sacripante”). Claim 15 stands rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Bartel, as evidenced by Fields and Sacripante.

These rejections are respectfully traversed in the following discussion.

## I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1 provides an electrostatic charge image developing toner wherein a melting point of at least one of the plurality of wax components, which is defined as a maximum peak of the absorbed heat quantity curve at a time of temperature rise, is set in a range of 50 °C to 120 °C in a DSC curve measured by the differential scanning calorimeter (e.g., see Application at page , lines ). This feature is important for providing a toner capable of achieving stable printing with limited variation due to the printing environment (see Application at page 7, line 24 through page 8, line 1). The wax having the plurality of wax components has a molecular weight distribution that is rationalized by combining the waxes. The molecular weight is rationalized by including an appropriate amount of a low molecular weight wax component in the wax (see Application at page 11, lines 14-20).

## II. RESTRICTION REQUIREMENT

The Examiner has restricted the examination of the Application to the invention disclosed in claims 1-15, 18 and 19.

Applicants respectfully traverse the Restriction Requirement for the following reasons. Although Groups I and II may be classified in different classes and subclasses, the Examiner's search with regard to the Group I and II claims would be coextensive, such that there would be no additional searching burden placed on the PTO if the examination of all of the Group I and II claims was conducted in the same application.

Further, even assuming arguendo that a slight, additional searching burden was imposed upon the PTO if all of the Group I and II claims were examined in the same application, the burden to the Applicants would be much greater in terms of financial considerations, since a divisional application is likely to be filed. Divisional applications are costly, with the present filing, issue and maintenance fees alone being \$5,000. Thus, from a financial standpoint, Applicant's costs associated with filing and prosecuting a divisional application are believed to outweigh any additional costs (e.g., due to searching) incurred by the PTO if claims 1-19 were to be examined in the same application.

For the above reasons, Applicants respectfully request that the Examiner withdraw the Restriction Requirement, and examine the claims of Groups I and II in the same application.

### **III. NEW MATTER OBJECTION**

The Examiner has objected to the Amendment filed on December 9, 2004 under 35 U.S.C. 132(a) for introducing new matter into the disclosure. The Examiner, however, is clearly incorrect.

That is, in the Examiner's Office Action dated September 22, 2004, the Examiner objected to the Specification because "In example 1, the sum of the amounts of the components in the toner, i.e., 85 wt% for binder resin, 1 wt% for charge control agent, 10 wt% for carbon black, 4.25 wt% for polyethylene wax, and 0.75 wt% for paraffin wax, is 101 wt%. It is not clear how the sum of weight percentages based on the total weight of the toner can be other than 100 wt%" (see Office Action dated September 22, 2004 at page 2). In the Amendment filed on December 9, 2004 Applicants amended the Specification to recite 84 wt % of binder resin to correct an apparent typographical error.

Applicants respectfully submit that it would have been apparent to one of ordinary skill in the art that Applicants merely amended the specification to correct a typographical error and did not add new matter to the Specification.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this objection.

### **IV. THE 35 USC §112, SECOND PARAGRAPH, REJECTION**

Claims 1-15, 18 and 19 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claims 1, 3, 5-7, 11, 12, 16 and 18 above to overcome the Examiner's rejection.

However, regarding the Examiner's rejection of claims 9-13, Applicants respectfully traverse the Examiner's rejection. That is, the Examiner alleged that language "at least one of..." in claims 9-13 is indefinite because it is not clear whether the claim requires one or all of the components recited after the phrase "at least one of...". Applicants respectfully disagree.

The MPEP clearly states that phrases such as "at least one piece" have been held acceptable and not in violation of 35 U.S.C. 112, second paragraph (see MPEP 2173.05(i)). Therefore, Applicants respectfully submit that the phrase "at least one of..." recited in claims

9-13 clearly does not render claims 9-13 indefinite.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **V. THE 35 USC §112, FIRST PARAGRAPH, REJECTION**

Claims 1-15, 18 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended claims 1, 3, 5, 6, 7, 15 and 18 above to overcome the Examiner's rejection.

However, regarding the Examiner's rejection of claims 8-10 and 13, Applicants respectfully traverse the Examiner's rejection.

That is, regarding claims 8-10, the Application clearly states that "In the present invention, the wax can be obtained from the natural wax or the synthetic wax. There are animal/plant wax, mineral wax and petroleum wax as the natural wax. There are Fischer-Tropsch wax, polyethylene wax, etc. as synthetic wax" (see Application at page 15, lines 19-23).

The Examiner alleges that Examples 1 and 2 of the Application do not provide support for the limitations of claims 8-10. However, Applicants submit that Examples 1 and 2 are merely non-limiting examples of certain exemplary embodiments of the invention. One of ordinary skill in the art would clearly understand that Applicants did not intend to limit themselves to the features provided in Examples 1 and 2. Furthermore, Applicants have provided clear support in the Specification (as indicated above) for the limitations of claims 8-10.

Furthermore, the Application clearly provides support for "an alpha olefin wax" as recited in claim 13. The Application at Table 1 and page 30, lines 11-12 provide support for "an alpha olefin wax" as recited in claim 13.

Applicants submit that Examples provided in an Application are merely exemplary, and do not limit the claimed invention to the exemplary features recited therein.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **VI. THE EXAMINER'S INTERPRETATION OF THE CLAIMS**

Regarding the Examiner's interpretation of claims 9-13, the Examiner indicated that

she "has interpreted the claim language in claims 9, 10, 11, 12, and 13 as requiring only one of the recited components" (see Office Action dated June 13, 2005 at page 19). Applicants respectfully disagree.

That is, the language of claims 9-13 clearly recites at least one of the recited components.

## VII. THE PRIOR ART REFERENCES

### A. The Onuma Reference

The Examiner alleges that Onuma (as evidenced by Schaffert) teaches the claimed invention of claims 1, 2, 5, 6, 8, 9 and 11-13. Furthermore, the Examiner alleges that the invention of claims 4 and 19 is anticipated, or in the alternative, would have been obvious in view of Onuma. Additionally, the Examiner alleges that the claimed invention of claims 7 and 10 would have been obvious in view of Onuma. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by (nor made obvious in view of) Onuma.

First, Applicants submit that the Examiner has failed to establish a proper case of anticipation. That is, the MPEP clearly states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (see MPEP 2131) (emphasis added). In the present rejection the Examiner is improperly relying on more than one reference to establish an anticipation rejection. Therefore, if the Examiner wishes to maintain this rejection Applicants respectfully request the Examiner to provide a single reference, which teaches or suggests each and every feature of the claimed invention.

Moreover, Onuma does not teach or suggest an electrostatic charge image developing toner "*wherein a melting point of at least one of said plurality of wax components, which is defined as a maximum peak of the absorbed heat quantity curve at a time of temperature rise, is set in a range of 50 °C to 120 °C in a DSC curve measured by the differential scanning calorimeter*" as recited in claim 1, and similarly recited in claim 5.

Indeed, the Examiner attempts to rely on Table 2, example 9 of Onuma to support her allegations. However, Applicants submit that the Examiner is clearly incorrect.

That is, nowhere, in this passage (nor anywhere else for that matter) does Onuma teach or suggest an electrostatic charge image developing toner wherein a melting point of at least

one of the plurality of wax components, which is defined as a maximum peak of the absorbed heat quantity curve at a time of temperature rise, is set in a range of 50 °C to 120 °C in a DSC curve measured by the differential scanning calorimeter. Indeed, the Examiner does not even allege that Onuma teaches or suggests this feature.

The Examiner merely alleges that Onuma teaches an exemplary wax that has a temperature in a range of 50 °C to 120 °C. Onuma merely teaches one example of the melting temperature of the wax and does not provide a range for the wax melting temperature, let alone teach or suggest the specific range recited in claims 1 and 5. Furthermore, Onuma fails to recognize the significance of this parameter.

In contrast, Applicants have discovered the significance of the melting temperature of the wax in the electrostatic charge image developing toner. As pointed out in the Application, Applicants have discovered that the fusing property of the toner is increased and also the high-temperature offset is readily caused if the melting point of the wax is below 50 °C, while the fixing property of the toner is lowered if the melting point of the wax is in excess of 120 °C (see Application at page 12, lines 5-11). Applicants believe that the claimed range recited in claim 1 (and similarly claim 5) is an important contribution to the art for achieving the desired results of the claimed invention.

Applicants point out that MPEP 2144.05 states that “[t]he law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims”. That is, a specific range or other variable in a claim may provide patentable weight to a claim if the applicant can show that the particular range is important (see MPEP 2144.05). In order to anticipate this claimed range, the specific limitation must be disclosed in the reference with “sufficient specificity to constitute an anticipation under the statute” (see MPEP 2131.03). As stated above, Onuma does not even mention a relationship between the melting point of the wax in the toner and the fusing property, high-temperature offset and fixing property of the toner, let alone teach or suggest the specific ratio recited in claim 1, and similarly recited in claim 5. That is, Onuma clearly fails to recognize the significance of this parameter.

Therefore, the specific range recited in exemplary claim 1 (and similarly claim 5) clearly shows a technical effect and is not arbitrarily selected to solve the problems presented in the Application.

Therefore, Applicants submit that there are elements of the claimed invention that are

not taught or suggested by Onuma. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**B. The Bartel Reference**

The Examiner alleges that Bartel (as evidenced by Fields and Sacripante) teaches the claimed invention of claims 1, 6 and 11-14. Furthermore, the Examiner alleges that the invention of claim 15 is anticipated, or in the alternative, would have been obvious in view of Bartel, as evidenced by Fields and Sacripante. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by (nor made obvious in view of) Bartel.

First, Applicants submit that the Examiner has failed to establish a proper case of anticipation. That is, the MPEP clearly states that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” (see MPEP 2131) (emphasis added). In the present rejection the Examiner is improperly relying on more than one reference to establish an anticipation rejection. Therefore, if the Examiner wishes to maintain this rejection Applicants respectfully request the Examiner to provide a single reference, which teaches or suggests each and every feature of the claimed invention.

Moreover, Bartel does not teach or suggest an electrostatic charge image developing toner “*wherein a melting point of at least one of said plurality of wax components, which is defined as a maximum peak of the absorbed heat quantity curve at a time of temperature rise, is set in a range of 50 °C to 120 °C in a DSC curve measured by the differential scanning calorimeter*” as recited in claim 1, and similarly recited in claim 5.

Indeed, the Examiner attempts to rely on column 12, lines 60-61, Example VI at column 20, and column 21, lines 11-14 of Bartel to support her allegations. However, Applicants submit that the Examiner is clearly incorrect.

That is, nowhere, in this passage (nor anywhere else for that matter) does Bartel teach or suggest an electrostatic charge image developing toner wherein a melting point of at least one of plurality of wax components, which is defined as a maximum peak of the absorbed heat quantity curve at a time of temperature rise, is set in a range of 50 °C to 120 °C in a DSC curve measured by the differential scanning calorimeter. Indeed, the Examiner does not even allege that Bartel teaches or suggests this feature.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested by Bartel. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **VIII. FORMAL MATTERS AND CONCLUSION**

In response to Examiner's objections, the specification and claims have been amended in a manner believed fully responsive to all points raised by the Examiner. Applicants have reviewed the Application and amended all instances of trademarks in the Application, such that all trademarks have been capitalized.

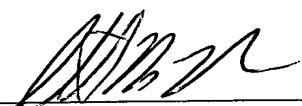
In view of the foregoing, Applicant submits that claims 1, 3-16 and 18, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: December 13, 2005

  
\_\_\_\_\_  
Scott M. Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn, Esq.  
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY  
LAW GROUP, PLLC**  
Intellectual Property Law  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
**Customer No. 21254**